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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,734	12/28/2001	Salman Akram	2754.4US (95-0742.4)	6382
24247	7590	02/27/2006	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			GRAYBILL, DAVID E	
			ART UNIT	PAPER NUMBER
			2822	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/032,734	Applicant(s) AKRAM ET AL. 	
	Examiner David E. Graybill	Art Unit 2822	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,11-21,23-26 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,11-21,23-26 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 5-7, 11-16, 20, 21, 35 and 36 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is insufficient antecedent basis for the following language:

Claim 2, "the at least one other third position";

Claim 5, "the as least one other vacant position";

Claims 20 and 21, "the at least one other third predetermined configuration";

Claim 35, "the second vacant predetermined configuration position."

Claims 2, 5-7, 11-16, 20, 21, 35 and 36 have not been rejected over the prior art because, in light of the 35 U.S.C. 112 rejections supra, there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of the claims; hence, it would not be proper to reject the claims on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims. Also see *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning

can be ascribed to certain claim language, the claim is indefinite, not obvious). See also MPEP 2143.03 and 2173.06.

In the rejections *infra*, generally, reference labels are recited only for the first recitation of identical claim elements.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 17-19, 23-25 and 29-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Corbett (4992850).

Corbett is applied to the rejection for the same reasons it was applied to claims 5-7, 11-16, 18, 23-25 and 29-36 in the previous Office action.

Applicant's amendment and remarks filed 12-8-5 have been fully considered, are addressed by the rejections *supra*, and are further addressed *infra*.

Applicant asserts, "that the Corbett et al. reference fails to describe, either expressly or inherently, the elements of the claimed inventions of presently amended independent claims 1, 5, 17, 19, 23, and 25 calling for 'having at least one second position having, in turn, a predetermined configuration for locating a second semiconductor device thereat on the

multi- chip module system, the at least one other vacant position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position', 'a substrate . . . having a third position having, in turn, a predetermined configuration for locating a third semiconductor device thereat, the third position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position, and having a fourth position having, in turn, a predetermined configuration for locating a fourth semiconductor device thereat on the multi-chip module system, the second vacant position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position', and 'a substrate . . . having a third predetermined configuration position for locating a third semiconductor device thereat, the third predetermined configuration position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position, and having a fourth predetermined configuration for locating a fourth semiconductor device thereat on the multi-chip module system, the fourth predetermined configuration position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position'."

This assertion is respectfully deemed unpersuasive because the scope of the claims is not limited to, "a substrate . . . having a third position having, in turn, a predetermined configuration for locating a third semiconductor device thereat, the third position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position, and having a fourth position having, in turn, a predetermined configuration for locating a fourth semiconductor device thereat on the multi-chip module system, the second vacant position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position," and, "a substrate . . . having a third position having, in turn, a predetermined configuration for locating a third semiconductor device thereat, the third position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position, and having a fourth position having, in turn, a predetermined configuration for locating a fourth semiconductor device thereat on the multi-chip module system, the second vacant position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position," and Corbett is not applied to the rejections for this disclosure. Also, the scope of claims 1, 5, 17, 19 and 23 is not limited to, "a substrate . . . having

a third predetermined configuration position for locating a third semiconductor device thereat, the third predetermined configuration position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position, and having a fourth predetermined configuration for locating a fourth semiconductor device thereat on the multi-chip module system, the fourth predetermined configuration position having no semiconductor device located thereat until a semiconductor device is installed to replace a defective semiconductor device at another position," and Corbett is not applied to claims 1, 5, 17, 19, 23 and 35 for this disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2822

For information on the status of this application applicant should check PAIR:

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.
The fax phone number for group 2800 is (571) 273-8300.



David E. Graybill
Primary Examiner
Art Unit 2822

D.G.
19-Feb-06